

### **REMARKS/ARGUMENTS**

Upon entry of the instant amendment, claims 1-4, 8-24, and 58-60 are pending in the instant application and under consideration. Claims 5-7, and 25-57 have been canceled. Claims 58-60 are new. Claims 1-3 have been amended, support for which can be found throughout Applicant's Specification, for example, on page 9, lines 25-30 and page 16, lines 10-15.

#### **Restriction Requirement**

The Examiner further restricted the claims by stating that claim 27 was mistakenly added to Group 1 but rather belongs with Group 2. Applicants have canceled claim 27 along with claims 5-7, 25-26, and 28-57, without any intention to abandon the subject matter as filed, but with the intention that claims of the same, greater, or lesser scope may be filed in a continuing application.

#### **Rejection Based on Nonstatutory Double Patenting**

The Examiner rejected claims 1-24 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,639,088. Not in acquiescence of the rejection but in order to expedite allowance of the claims, Applicants submit a Terminal Disclaimer herewith to obviate the rejection.

#### **Rejections Under 35 U.S.C. §102**

The Examiner rejected claims 1-15 under 35 U.S.C. §102(b) as being unpatentable over Bonfils et al. (1991) Tetrahedron Letters, 32:3053-3056 ("Bonfils"). Applicant traverses the rejection to the extent it is maintained over the claims as amended.

Applicant's claim 1 recites a hydrocarbyldithiomethyl-modified compound comprising the formula  $R^1-O-CH_2-S-S-R^2$  or a salt thereof, wherein  $R^1$  is a nucleotide, a nucleoside, or an analog thereof,  $R^2$  is a hydrocarbyl, and wherein cleavage of the disulfide bond produces a free hydroxyl. As Applicant's Specification discloses, reducing the disulfide of claim 1 results in spontaneous secondary elimination to produce a free hydroxyl. (Applicant's Specification, page

16, lines 10-15). The resulting product has the formula  $R^1-OH$ . Specifically, Applicant's Specification discloses and claims a compound that generates an unstable thiolmethoxy function that spontaneously decomposes to create a free hydroxyl group after the disulfide is reduced. (Applicant's Specification, page 16, lines 10-15).

Applicant respectfully submits that Bonfils does not disclose, reasonably suggest, or enable the claimed invention. Bonfils discloses organic molecules having a disulfide bond and a hydrocarbyl moiety. (Bonfils, page 3053, paragraph 4). Bonfils does not disclose or suggest cleavage of the disulfide bond that results in a secondary elimination that produces a free hydroxyl. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection.

### Conclusion

Applicant submits that the claims are in condition for allowance. Applicant believes a telephonic interview with the Examiner would expedite prosecution of this application. The Examiner is therefore cordially invited to call the undersigned at (617) 338-2952 at his earliest convenience.

Respectfully submitted,



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